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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,859	06/12/2001	Nanda D. Sinha	2733.1003-001	3484

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EXAMINER

RILEY, JEZIA

ART UNIT PAPER NUMBER

1637

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,859

Applicant(s)

SINHA, NANDA D.

Examiner

Jezia Riley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 1,24,47 and 66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-23,25-46,48-65 and 67-97 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/12/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of the species in the reply filed on 11/3/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The claims that read on the species election are 2-23, 25-46, 48-65, 67-97.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "with the aqueous basic solution" in 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 2-6, 8-10, 14, 15, 18-22, 25-28, 31-33, 37-45, 48-52, 54-64, 67-72, 75-79, 81, 82, 85-97 are rejected under 35 U.S.C. 102(b) as being anticipated by Sinha (Nucleic Acids Research, Vol.12, 1984, p4539-4557).

Sinha et al discloses deprotection of a synthetic oligonucleotide. Cleavage of the oligo from the polymer support (CPG page 4544), deacylation and deprotection of β -cyanoethyl group from the phosphate triester moiety can be performed in one step with concentrated aqueous ammonia (see abstract).

They disclose using a hindered primary amine $t\text{BuNH}_2$ /pyridine mixture for the removal of β -cyanoethyl group prior to contacting with an aqueous basic solution (conc. Aqueous NH_3). The NH_3 solution is viewed as the instant aqueous basic solution and the hindered primary amine $t\text{BuNH}_2$ /pyridine mixture is viewed as organic solvent and scavenger of instant claim 3. (page 4546). Page 4545 shows oligo sequences comprising at least 50% of combined thymine and Guanine. Further the result solution after adding the NH_3 solution to the $t\text{BuNH}_2$ /pyridine mixture is viewed as a solution

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comprising aqueous NH₃ and t-butylamine and therefore is viewed to be inclusive of instant claims 48 and 49.

The term "provided that when" makes it optional that the acrylonitrile scavenger comprises a primary aliphatic amine.

5. Claims 2-5, 7-23, 25-46, 67-97 are rejected under 35 U.S.C. 102(e) as being anticipated by Ravikumar et al. (US 6,465,628 B1).

Ravikumar et al. provides an improved method for the preparation of phosphate-linked oligomers having phosphodiester, phosphorothioate, phosphorodithioate or other linkages that have significantly reduced amounts of exocyclic nucleobase adduct resulting from the products of removal of phosphorus protecting groups. (see col. 10—12 and claims). A preferred synthetic solid phase synthesis utilizes phosphoramidites as activated phosphate compounds. The examples shows synthesis of oligos containing at least 50% thymine or guanine or wherein all the nucleobases are thymine on solid support. Example 22 shows decyanoethylation with aqueous aliphatic amine. Example 23 shows cleavage from the solid support using ammonium hydroxide. In col. 34, it claimed that the deprotecting agents have a pka of from 8-11, which is viewed to be inclusive of tert-butylamine (pka 10.45). In col. 34, it is claimed that both solid support and protecting group can be cleaved by the cleaving agents which can further comprise one or more solvents. In col. 35 it is claimed that the cleaving agent comprises an aqueous solution of group or ii metal carbonate, or metal hydroxide. Col.25-28, show

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treatment with organic solvent and a scavenger, prior to treatment with an aqueous basic solution.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinha (Nucleic Acids Research, Vol.12, 1984, p4539-4557) in view of Ravikumar et al. (US 6,465,628 B1).

Sinha et al. disclose using a hindered primary amine tBuNH₂/pyridine mixture for the removal of β -cyanoethyl group prior to contacting with an aqueous basic solution (conc. Aqueous NH₃). The NH₃ solution is viewed as the instant aqueous basic solution and the hindered primary amine tBuNH₂/pyridine mixture is viewed as organic solvent and scavenger of instant claim 3. (page 4546). Page 4545 shows oligo sequences comprising at least 50% of combined thymine and Guanine.

Ravikumar et al. provides an improved method for the preparation of phosphate-linked oligomers having phosphodiester, phosphorothioate, phosphorodithioate or other linkages that have significantly reduced amounts of exocyclic nucleobase adduct

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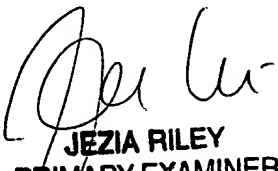
resulting from the products of removal of phosphorus protecting groups. (see col. 10—12 and claims).

Therefore it would have been obvious at the time the invention was made to apply the method of Sinha for the removal of protecting group from phosphorothioate oligo analogs since Ravikumar teaches an improved method for the preparation of oligos comprising such linkages or any kind of linkages and also any oligos which can comprise any mixture of nucleobases or only thymine nucleobases.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is 571-272-0786. The examiner can normally be reached on 9:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JEZIA RILEY
PRIMARY EXAMINER